



Docket No.: HENRYWU.007A

February 22, 2006

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TRANSMITTAL LETTER

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Applicant : Henry Wu
App. No : 09/943,483
Filed : August 29, 2001
For : FOLDING CHAIR
Examiner : Brian Green
Art Unit : 3611

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

February 23, 2006

(Date)

Michael H. Trenholm, Reg. No. 37,743

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

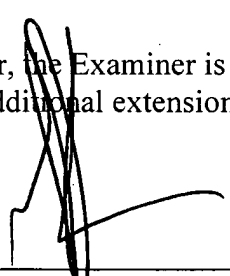
Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Amended Appeal Brief in eleven (11) pages in response to Notice of Non-Compliant Appeal Brief dated January 24, 2006.
- (X) Return prepaid postcard.

No fees are believed to be due at this time. However, the Examiner is hereby authorized to charge any fees that may be due, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Dated: February 23, 2006



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HENRYWU.007A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Henry Wu)	Group Art Unit 3611
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Appl. No.	:	09/943,483)	
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Filed	:	August 29, 2001)	
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For	:	FOLDING CHAIR)	
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Examiner	:	Brian Green)	
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ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPELLANT'S BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant, in the above-identified patent application, appeals the final rejection of Claims 7-9, 12, 13, 15-21, 32 and 33 which were rejected in the Final Office Action mailed May 10, 2005.

I. REAL PARTY IN INTEREST

The real party in interest is Henry Wu, the Applicant in the above-identified application.

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II. RELATED APPEALS AND INTERFERENCES

No appeals or interferences related to this case is currently pending.

III. STATUS OF CLAIMS

Claims 1-6, 10, 11, and 22-31 have been canceled. Claim 14 is objected to for depending from a rejected claim. Claims 7-9, 12, 13, 15-21, 32 and 33 are rejected and are being appealed.

IV. STATUS OF AMENDMENTS

No amendment has been filed since the Final Office Action mailed May 10, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed subject matter of the present invention generally relates to a folding chair having a padded sign, and is addressed by independent claims 7 and 15. Claim 7 recites a folding chair (generally described in page 13, line 1 to page 15, line 8, in reference to Figures 6A, 6B, and 7) having a back rest portion (316 in Figure 6A). The back rest portion (316) includes first and second edges (333a and 333b) disposed opposite each other. Claim 7 further recites a padded sign (312) having a main body (380) with first and second edges (see Figures 6A and 6B) that are also disposed opposite each other. The padded sign further includes at least one first retainer that extends from the first edge of the main body so as to hook over the first edge of the back rest portion (see Figures 6A and 6B, and page 13, lines 3-5). Similarly, the padded sign further includes at least one second retainer that extends from the second edge of the main body so as to hook over the second edge of the back rest portion. The first and second retainers are interconnected by the main body, and are formed from flexible material to allow installation and removal of the padded sign from the back rest portion of the folding chair. The padded sign further includes a padding (381 in Figure 6A) attached to the main body.

Claim 15 is also directed to a folding chair, and includes limitations that are similar to that of Claim 7. However, Claim 15 does not include limitations such as chair legs and a seat portion.

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The folding chair as claimed in Claim 7 or 15 can have a message inscribed on the padded sign. Thus, the padded sign provides a functionality of a removable padding that can also provide a visual display such as advertising.

VI. GROUND OF REJECTION

The following rejections have been issued by the Examiner:

Claims 7-9, 12, 13, 15-21, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald (U.S. Patent No. 1,847,605 – “Fitzgerald”) in view of Neal (U.S. Patent No. 5,779,317 – “Neal”) and Taylor (U.S. Patent No. 4,884,353). Claims 7 and 15 are independent claims.

VII. ARGUMENT

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald in view of Neal and Taylor. For reasons discussed below, Applicant respectfully submits that none of the cited references, individually or in any combination, teaches nor makes any suggestion to modify and/or combine various features to arrive at the unique combination as recited in claim 7.

Fitzgerald

The Examiner relies on Figures 10 and 12 of Fitzgerald as the basis for the obviousness rejection. Upon review of Fitzgerald, Applicant notes that the only relevant feature of Fitzgerald appears to be the concept of securing a display sign on the back rest portion of a chair (as shown in Figure 12). The “FOR SALE” sign 24 is shown to be secured to the back rest 25 by a pair of springs (12 in Figure 10) having hooks 7 and 8.

The Examiner refers to the sign 24 as the main body panel. Applicant notes that in Fitzgerald, the sign 24 or the “main body panel” is not dimensioned to conform to the shape of the back rest 25. In fact, because of the nature of the spring-and-hooks assembly, it is preferable in Fitzgerald to have the sign 24 be wider (vertically) than the vertical dimension of the depicted back rest 25. To form a secure hooking of the hooks 7 and 8 over the edges of the sign 24, the

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spring 12 should preferably be stretched at least a little. However, if the sign 24 had a vertical width similar to that of the back rest 25 (or the bumper 5 in Figure 3, or the lamp mounting rod 20 in Figure 4), the spring will likely not stretch sufficiently to provide the hooking action. Thus, Fitzgerald does not suggest at all the concept of the main body panel being dimensioned to conform to the shape of the back rest.

The Examiner also states that in Fitzgerald, the first and second retainers (hooks 7 and 8) extend from the first and second edges of the main body panel (sign 24). Applicant notes that this is not the case. The spring-and-hooks assembly is a completely separate structure from the main body panel (sign 24); and thus the hooks 7 and 8 cannot extend from the edges of the sign. The hooks 7 and 8 engage the edges, but they do not extend from the edges.

The Examiner also states that in Fitzgerald, the main body panel (sign 24) connects the first and second retainers (hooks 7 and 8). Applicant disagrees – the hooks 7 and 8 are interconnected by the spring 12, and not by the panel/sign 24. Again, the hooks 7 and 8 engage the edges of the panel/sign 24, but are not interconnected by panel/sign 24.

Based on the foregoing, Applicant respectfully submits that Fitzgerald in no way suggests any of the features of claim 7, other than perhaps the concept of securing a sign to the back rest portion of a chair.

Neal

The Examiner relies on Figures 1-9 of Neal for the concepts of removably attaching a padded portion (30 in Figure 5) to a back rest portion (8 in Figure 1), and placing a message on the padded portion (Figures 7 and 9). The Examiner also relies on Neal for the concept of a folding chair having these two features.

Applicant notes that Neal emphasizes a particular method of providing the removable padded portion to the back rest portion and the seat portion. Specifically, great emphasis is placed on the concept of a raised locator area (item 5 for the seat back, and item 4 for the seat portion, in Figure 1) that allows alignment and cooperation of the corresponding attachment holes 12 on the padded parts (11 and 30 in Figures 2 and 5) and the attachment holes 7 on the seat back and the seat portion (Figure 1). Thus, Neal teaches a concept of precise matching of

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the padded parts to the seat back and the seat portion by a combination of the raised locator and the matching attachment holes. Neal achieves such precision by providing generally unnatural protrusions on the seat back and the seat portion, as well as requiring use of multiple fasteners.

Applicant notes that Neal does *not* disclose or suggest any other method of attaching the padded portion to the back rest portion or the seat portion. In particular, Neal does not suggest the concept of hook-shaped retainers that extend from the main body of the padded sign. In fact, Neal may even discourage such a practice because the fit may not be precise enough.

Based on the foregoing, Applicant respectfully submits that Neal in no way suggests the combination of features recited in claim 7.

Taylor

The Examiner relies on Figures 1 and 3 of Taylor for the concepts of a sign holder (10 in Figure 1) having a padding (62 in Figures 2-4) and a sign panel (14 in Figure 1).

Applicant notes that Taylor teaches the concept of a front loading sign assembly. In particular, a fulcrum (60 in Figures 2, 6, and 9) is provided so as to allow a temporary deformation of the sign panel (14), thereby allowing a portion of the sign to be exposed for removal (Figures 4 and 9). The fulcrum 60 can be formed by the padding 62 (Figures 2-4). However, the padding 62 in Taylor is not contemplated for any form of comfort-based use.

Applicant further notes that the sign assembly of Taylor is not contemplated for use in a chair setting, no less in a folding chair setting. The Taylor sign assembly provides mounting holes 26 (Figures 2 and 6) "for the purpose of supporting the sign assembly 10 through the instrumentality of screws 27 fastened into a vertical sign support wall 28." (Column 3, lines 17-20).

Based on the foregoing, Applicant respectfully submits that Taylor in no way suggests the combination of features recited in claim 7.

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There is No Suggestion to Combine Fitzgerald, Neal, and Taylor

The Examiner stated in the Final Office Action (mailed May 10, 2005) that it would have been obvious to one of ordinary skill in the art to modify Fitzgerald in view of Neal and/or Taylor to arrive at various features as recited in claim 7. Applicant respectfully disagrees with such a conclusory statement. As discussed above, each cited reference at best discloses one or more features that are completely isolated from the combination of features of claim 7. None of the references even remotely suggests extending its disclosed concept to the desirability of the recited combination.

As discussed herein, Fitzgerald does not suggest at all the concept of the main body panel being dimensioned to conform to the shape of the back rest. Furthermore, Fitzgerald teaches use of completely separate spring-hooks based retainers that allow mounting to different sized mounting structures; and thus the hooks do not extend from the edges of the main body panel. Moreover, Fitzgerald does not teach or suggest retaining hooks that are interconnected by the main body panel, because the hooks are in fact connected by the springs to provide the intended functionality.

As also discussed herein, Neal teaches a concept of precise matching of the padded parts to the seat back and the seat portion by a combination of the raised locator and the matching attachment holes. Neal achieves such precision by providing generally unnatural protrusions on the seat back and the seat portion, as well as requiring use of multiple fasteners. Thus, Neal does *not* disclose or suggest the concept of hook-shaped retainers that extend from the main body of the padded sign.

As also discussed herein, Taylor does not teach or suggest use of its sign assembly in a chair setting, no less in a folding chair setting. The Taylor sign assembly is intended to be mounted to a support wall via screws. Taylor also does not teach the concept of hook-shaped retainers, or the concept of a padding on which visual signs can be inscribed.

Based on the foregoing, Applicant respectfully submits that there is no suggestion to combine Fitzgerald with Neal and/or Taylor. Applicant notes that the U.S. Court of Appeals for the Federal Circuit has ruled that “[o]bviousness cannot be established by combining the

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teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). In the present application, none of the prior art references provides the suggestion or incentive. Moreover, the Examiner has not provided any support for such suggestion or incentive.

Applicant further notes that the Federal Circuit has also ruled that failure of the Examiner to provide the necessary suggestion or motivation creates a presumption that references cited by the Examiner to support the obviousness rejection was based on hindsight. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The Federal Circuit “forbids the use of hindsight in the selection of references that comprise the case of obviousness.” *Id.*

Applicant further notes that even if Fitzgerald, Neal, and Taylor were to be combined in any manner, the resulting combination still would not yield all of the limitations as recited in claim 7. In a non-limiting example, hook-shaped retainers that extend from the main body panel of a padded sign constitute a feature that is not present in any combination of Fitzgerald, Neal, and Taylor.

Conclusion

In view of the foregoing, Applicant respectfully requests that the rejection of claims 7 be reversed. Furthermore, Applicant requests that the rejection of claim 15, and the dependent claims that depend on claims 7 and 15, also be reversed for at least the foregoing reasons.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/23/06

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VIII. APPENDIX

The following claims are involved in the appeal:

Claims 1-6 (Canceled).

7. (Previously presented) A padded sign displaying apparatus, comprising:
- a folding chair having a pair of spaced legs and a seat portion and a back rest portion that extends between the spaced legs wherein the back rest portion provides support for a person's back when sitting on the seat portion wherein the back rest portion includes a first edge and a second edge that is disposed opposite from the first edge; and
 - a padded sign comprising:
 - a main body having dimensions that conform to dimensions of the back rest portion such that the main body also includes a first edge and a second edge that is disposed generally opposite from the first edge of the main body, wherein the main body comprises a panel that defines a front surface and a rear surface;
 - at least one first retainer that extends from the first edge of the main body, wherein each of the at least one first retainer has a hook shape that is biased towards the rear surface of the main body such that the at least one hook shaped first retainer can be urged over the first edge of the back rest portion thereby retaining the first edge of the main body adjacent the first edge of the back rest portion;
 - at least one second retainer that extends from the second edge of the main body, wherein each of the at least one second retainer has a hook shape that is biased towards the rear surface of the main body such that the at least one hook shaped second retainer can be urged over the second edge of the back rest portion thereby retaining the second edge of the main body adjacent the second edge of the back rest portion, and wherein the at least one first retainer and the at least one second retainer are interconnected by the panel of the main body, such that the rear surface of the main body is positioned proximate the back rest portion of the chair and such that the front surface of the main body faces the person's back

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when the person's back is supported by the back rest portion wherein the at least one first and second retainers are formed of a flexible material that allows the user to urge the at least one first and second retainers into and out of engagement of the first and second edges of the back rest portion to install and remove the padded sign from the chair; and

a padding having an outer surface attached to the main body wherein a message is inscribed on the outer surface of the padding so as to be positioned in front of the front surface of the main body.

8. (Previously presented) The apparatus of Claim 7, wherein the main body and the plurality of retainers are constructed of plastic, wherein the plurality of retainers form contiguous extensions from the main body.

9. (Previously presented) The apparatus of Claim 8, wherein the main body is a ¼ inch thick plastic.

10. (Canceled).

11. (Canceled).

12. (Previously presented) The apparatus of Claim 7, wherein the padded sign attached to the back rest portion of the folding chair is contoured to the back rest portion so as to retain the functional profile of the back rest portion.

13. (Previously presented) The apparatus of Claim 7, wherein the padding is attached to the main body by securing the padding onto the rear surface of the main body.

14. (Previously presented) The apparatus of Claim 13, wherein the padding is stapled to the rear surface of the main body.

15. (Previously presented) A folding chair having a folded and an unfolded configuration comprising:

a back rest portion with an upper edge and a lower edge wherein the back rest portion provides support for a person's back when sitting on the folding chair; and

a main body comprising a panel having an upper edge and a lower edge;

a plurality of retainers that extend from the upper and lower edges of the main body, wherein each of the plurality of retainers has a hook shape that can be urged over its respective edge of the back rest portion so as to allow securing of the main body to the back rest portion, wherein the plurality of retainers include at least one upper retainer that extends from the upper edge of the main body and at least one lower retainer that extends from the lower edge of the main body wherein the at least one upper retainer and the at least one lower retainer are interconnected by the panel of the main body, and wherein the at least one upper and lower retainers are formed of a flexible material that allows the user to urge the at least one upper and lower retainers into and out of engagement of the upper and lower edges of the back rest portion to install and remove the main body from the chair; and

a padding attached to the main body such that the main body is interposed between the padding and the back rest portion and such that the padding defines a first surface that comes into contact with the person's back when the person's back is supported by the back rest portion and wherein a message is inscribed on the first surface of the padding such that the message is visible when viewed from in front of the folding chair.

16. (Original) The folding chair of Claim 15, wherein the folding chair with the sign displaying device attached to the back rest portion has substantially similar dimensions as a folding chair without the sign displaying device attached.

17. (Original) The folding chair of Claim 16, wherein the folding chair with the sign displaying device attached to the back rest portion can be folded and unfolded without removing the sign displaying device.

18. (Previously presented) The folding chair of Claim 17, wherein a plurality of folding chairs with sign displaying devices attached can be stacked together when in the folded configuration.

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19. (Original) The folding chair of Claim 15, wherein a user can sit on the unfolded folding chair and rest the user's back on the back rest portion of the folding chair with the sign displaying device attached to the back rest portion.

20. (Original) The folding chair of Claim 15, wherein the message displayed on the sign displaying device attached to the back rest portion enhances the appearance of the folding chair.

21. (Previously presented) The folding chair of claim 20, wherein a plurality of folding chairs with messages displayed on a plurality of sign displaying devices enhance an overall atmosphere of the gathering for which the folding chairs are being used.

Claims 22-31 (Canceled).

32. (Previously presented) The apparatus of Claim 7 wherein the first edge of the backrest portion and the first edge of the main body are oriented towards the top of the backrest portion and the second edge of the backrest portion and the second edge of the main body are oriented toward the bottom of the backrest portion.

33. (Previously presented) The folding chair of Claim 15, wherein the upper edge of the backrest portion and the upper edge of the main body are oriented towards the top of the backrest portion and the lower edge of the backrest portion and the lower edge of the main body are oriented towards the bottom of the backrest portion.

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